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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/572,736

03/21/2006

Wael Mohamed Nabil Lotfy

SAI-004.01

6896

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7590

02/27/2009

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EXAMINER

STROUD, JONATHAN R

ART UNIT

PAPER NUMBER

3774

MAIL DATE

DELIVERY MODE

02/27/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/572,736	Applicant(s) LOTFY, WAEI MOHAMED NABIL	
	Examiner JONATHAN R. STROUD	Art Unit 3774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/05/2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-42 is/are pending in the application.
- 4a) Of the above claim(s) 24, 27, 28 and 30-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23, 25, 26 and 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/05/2008</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

The drawings submitted with the specification are of sufficient quality and satisfy the requirements. Thus, the previously filed objection is withdrawn.

Specification

The majority of the specification has been amended and the previously-filed rejection is withdrawn. However, the amendments present new matter which has been improperly added to the application.

1. The amendment filed 12/05/2008 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:
2. Paragraph 0007: "The stent is fixed to the vessel, and the lining may be inflated or deflated inwardly from the stent to control the portion of the lumen available for flow in the stented region."
3. Paragraph 0016: "...on its inner aspect." and " It expands inwardly".
4. Nowhere in the originally filed specification is mention made or disclosed that the lining is inflated or deflated inwardly, or that the stent is fixed to the vessel.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

The previously-filed 35 USC 112 rejections have been addressed and are thus withdrawn.

Election/Restrictions

5. Newly submitted claims 24, 27, 28 and 30-42 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

6. They are a part of a generic independent claim directed to a Markush group, and it has been indicated not allowable, there was a provisional election of the species rejected, namely, the species 1 indicated in para. 0008. Thus, every dependent claim directed away from that previously-rejected embodiment is withdrawn from further consideration.

7. "If the Markush-type claim is not allowable, the provisional election will be given effect and examination will be limited to the Markush-type claim and claims to the elected species, with claims drawn to species patentably distinct from the elected species held withdrawn from further consideration." See MPEP 803.02.

8. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 24, 27, 28, 30, 31 and 33-42 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 23, 25, 26 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Strother 4,364,392.

Re claim 23, Strother discloses a balloon 11 catheter 15 that is in the form of a stent to be placed in a vessel, and made of a lining that is inflatable and deflatable, embodiment in fig. 9.

Re claim 25, Strother teaches the balloon can be made of a semi-permeable membrane, 71, porous polymer material plug 72.

Re claim 26, the term “totally inflatable” is redundant; anything that is inflatable is “totally inflatable”. Strother discloses a fully inflatable embodiment fig. 9.

Re claim 29, fig. 9.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JONATHAN R. STROUD whose telephone number is (571)270-3070. The examiner can normally be reached on Monday through Friday, 8:30 a.m. to 6 p.m..

Art Unit: 3774

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Isabella can be reached on (571)272-4749. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jonathan R Stroud/
Examiner, Art Unit 3774
/Thomas J Sweet/
Primary Examiner, Art Unit 3774